

### **REMARKS/ARGUMENTS**

In view of the following remarks, reexamination and reconsideration of this application, withdrawal of the rejections, and formal notification of the allowability of all claims as presented are earnestly solicited. In response to the Office Action, Applicants respectfully present the following remarks to highlight the patentable subject matter of the pending claims. It is believed that the pending claims define patentable subject matter over the references cited by the Examiner and notice to such effect is requested at the Examiner's earliest convenience.

#### **Claim Status**

Claims 1-75 are pending. Claim 28 has been amended in order to overcome the pending rejection under 35 U.S.C. §112. Independent Claims 1, 19, 35, 46 and 57 have been amended to overcome the pending rejection under 35 U.S.C. §103. The amendments find support throughout the as-filed specification and figures. Accordingly, no new matter has been added.

#### **Claim Rejections – 35 U.S.C. §112**

Examiner has rejected Claim 28 under 35 U.S.C. §112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Examiner correctly points out that Claim 28 should depend from Claim 19. In response, Claims 28 has been amended to depend from Claim 19, as suggested by the Examiner. It is believed that these amendments serve to overcome the pending rejection of Claim 28 under 35 U.S.C. §112, second paragraph.

#### **Claim Rejections – 35 U.S.C. §103**

Examiner has maintained the rejections of Claims 1-75 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,738,159 to O'Brien ("O'Brien") in view of U.S. Patent No. 3,487,875 to Shukat *et al.* ("Shukat"). In particular, Examiner has stated that O'Brien discloses the claim elements of Claim 1-75 except the "slats, or equivalent thereto, dowels." The Examiner further cites Figure 5 of Shukat and states that "it would have been obvious to modify O'Brien to have such slats so as to provide defined pleats." Furthermore, in response to

Applicants' previously presented remarks, Examiner has stated that "regarding the combination of Shukat et al with O'Brien, there are several features of O'Brien other than potential ballooning or scalloped shapes." Furthermore, Examiner asserts that "Primarily, O'Brien is a raisable panel that can be mounted on conventional curtain rods" and that "modifying O'Brien to have slats does not limit this feature or many other features, of O'Brien."

In response, each of the Independent Claims 1, 19, 35, 46 and 57 have been amended to explicitly recite that the raisable window treatment, when raised, forms only horizontal stacking pleats free of ballooning, billowing and scalloping. Thus, the claimed raisable window treatment of the present application is fundamentally and structurally distinct from each of the only three window drape configurations disclosed in O'Brien.

More particularly, and contrary to the Examiner's assertions, O'Brien does not disclose "features other than potential ballooning or scalloped shapes." As shown in Figures 12, 14, 17 and 20, the various "selectively adjustable appearances" disclosed in O'Brien are limited to: (1) a scalloped "Austrian Drape" (See O'Brien, column 3, lines 21-22); (2) a "balloon drape" (See O'Brien, column 3, lines 23-34); and a "a genuine tab drape" (See O'Brien, column 7, lines 33-34 and Figures 17 and 20). No additional configurations or embodiments are disclosed. Furthermore, the "genuine tab drape" disclosed by O'Brien with reference to Figures 17 and 20 is not a "raisable panel" as specifically recited in the Claims of the present application.

Significantly, the proposed modification of the window drape of O'Brien with the addition of straight "stiffening members" (as generally disclosed in Shukat) would render the O'Brien window drape unsatisfactory for achieving the various indicated styles of O'Brien (such as the gathered, scalloped, and billowing styles disclosed in O'Brien with respect to Figures 12, 14, 17 and 20). Moreover, the addition of lateral "stiffening members" would also prevent the operation of the O'Brien window drape as a "genuine tab drape," which opens by laterally gathering the drape on one side of a window.

Consequently, as a matter of law, there can be no suggestion or motivation to modify O'Brien with the stiffening members of Shukat to obtain the claimed invention as is required to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). Furthermore, O'Brien teaches away from including slats or "stiffening members" in the disclosed "selectively adjustable" window drape, in that the scalloped features shown in Figure 12, for

example, could not be achieved.

Indeed, the Federal Circuit has held that **“if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”** See MPEP §2143.01, citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). O’Brien states that “it is a primary object of the present invention... to provide a window drape capable of being selectively arranged to achieve different styles.” See O’Brien, column 1, lines 51-54. Applicants respectfully submit that modification of the window drape of O’Brien with **the addition of straight “stiffening members”** (as generally disclosed in Shukat) **would render the O’Brien window drape unsatisfactory for achieving different styles (such as, for example, the gathered, scalloped, and billowing styles disclosed in O’Brien** with respect to Figures 12 and 14).

Furthermore, the Federal Circuit has consistently stated that a finding of obviousness requires **a specific teaching, motivation, or suggestion to combine the teachings of individual items of prior art**. See, e.g., *In Re Sang Su Lee*, No. 00-1158 (Fed. Cir. January 18, 2002) (**“factual question of motivation to combine** is material to patentability and **could not be resolved on subjective belief and unknown authority**); *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (**a showing of a suggestion, teaching, or motivation to combine is an essential evidentiary component** of an obviousness holding); *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (Examiner can satisfy burden of obviousness in light of combination only by showing some **objective teaching** leading to the combination); and *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (**evidence of teaching or suggestion essential to avoid hindsight**).

Instead of providing a motivation to combine the teachings of O’Brien and Shukat, O’Brien instead **teaches away from including slats or “stiffening members”** in the disclosed window drape, since O’Brien discloses a “window drape capable of being selectively arranged to achieve different styles” (see O’Brien, column 1, lines 53-54). More particularly, the window shade disclosed in O’Brien is disclosed as being capable of forming an “Austrian style drape” wherein the face panel is adjusted to **“be gathered upwardly.”** not horizontally pleated as required in the pending claims. See O’Brien, column 6, lines 43-63 and Figure 12. Furthermore,

the window drape of O'Brien is further disclosed as being capable of forming a "balloon shade" wherein the **lower end of the face panel is "gathered upwardly into a gently scalloped, billowing shape"** as shown in FIG. 14." See O'Brien, column 7, lines 1-11 and Figure 14. The slats or "**stiffening members**" (52, 54) disclosed generally by Shukat; in contrast, serve "**to prevent curling and wrinkling** of the sheet member." See Shukat, column 3, lines 53-54 (emphasis added). Thus, the slats or "stiffening members" disclosed by Shukat, would prevent the "upward gathering" and "scalloped, billowing shapes" or other "curling and wrinkling" shown in Figures 12 and 14 of O'Brien, if added to the window drape of O'Brien.

Thus, Applicants respectfully submit that there is no suggestion or motivation to modify the O'Brien window shade with the addition of the slats generally disclosed in Shukat.

### **CONCLUSION**

In conclusion, O'Brien or Shukat, alone or in combination **do not** teach, suggest, or provide motivation for the claimed invention. Accordingly, in view of the above differences between the Applicants' invention and the cited reference, Applicants submit that the present invention, as defined by the pending claims, is patentable over the references cited in the Office Action. As such, for the reasons set forth above, Claims 1-75 are believed to be in condition for immediate allowance and notice to such effect is respectfully requested at the Examiner's earliest opportunity.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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